

Serial No.: 09/220,830
Attorney Docket No.: E-826

Patent

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

OFFICIAL

In re patent application of:) Attorney Docket No.: E-826
Robert W. Sisson, et al.) Customer No.: 00919
Serial No.: 09/220,830)
Filed: December 24, 1998) Examiner: DIXON, Thomas A.
Confirmation # 5561) Group Art Unit: 3629
Date: May 3, 2004

Title: METHOD AND APPARATUS FOR THE REMOTE INSPECTION OF
POSTAGE METERS

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-9 of the above-identified application mailed October 29, 2003. Claims 1-9 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on March 1, 2004. This Brief is transmitted in triplicate. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on May 3, 2004 (Date of Transmission).
George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)


(Signature)

May 3, 2004 (Date)

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellant, his legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-9 are in the case and under final rejection of the Examiner.

Claims 1, 5, 8 and 9 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 5,812,400 to Eddy, et al. ("Eddy '400") in view of U.S. Patent No. 4,812,965 to Taylor ("Taylor '965").

Claims 2-4 and 6-7 stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 5,812,400 to Eddy, et al. ("Eddy '400") in view of GB 2,213,302 to Taylor ("Taylor '302") and further in view of U.S. Patent No. 5,731,980 to Dolan, et al. ("Dolan '980").

Appellant hereby appeals the rejection of claims 1-9.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of October 29, 2003. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Invention

Appellants' invention relates to the remote inspection of postage meters and verification of the current location of a postage meter. One system used an indicium card mailed to the registered address for the meter. Upon receipt, the registered user would print a zero dollar value indicia on the card and return it to the sender. The

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sender could then use cryptographic techniques to verify that the appropriate postage meter printed the indicia. However, such a system uses a manual return process that is subject to error and the process may be duped by a duplicate indicium card with a valid indicium printed thereon even if the postage meter is not at its registered location.

The present invention provides a method that securely verifies the location of a value dispensing system. A code associated with the system is generated at a data center. A challenge card is created with the code therein. The card is sent via a carrier service to a specific location. The code is then retrieved and communicated to the data center where the data center verifies that the system is physically located at the specified location.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Issues

Whether claims 1-9 are patentable under 35 U.S.C. §103(a).

VII. Grouping of Claims

Claims 1-9 are grouped in the following groups:

Group I – Claims 1, 5 and 8-9.

Group II - Claims 2-4.

Group III – Claims 6-7.

In Group I, independent claim 1, 8 and 9 and dependent claim 5 that depends directly from claim 1 stand or fall together.

In Group II, dependent claims 2-4 that depend directly or indirectly from claim 1 stand or fall together.

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In Group II, dependent claims 6-7 that depend directly or indirectly from claim 1 stand or fall together.

VIII. Argument

As Appellant discusses in detail below, the final rejection of several of claims 1-7 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The Dolan '980 Reference is Not Properly Combined Under 35 U.S.C. Section 103(a)

Appellant argues that there is no motivation to combine the references. For the rejection to stand, there must be some teaching, suggestion or motivation to combine the references found in the references themselves or the general knowledge of one of skill in the art. *Citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the Examiner used the invention itself as the roadmap to justify combining non-analogous references by stating that

Dolan teaches authenticating digital tokens ... Dolan teaches internal and external smart cards used in postage meters for refilling ... (October 29, 2003 Final Office Action, p.4.)

Appellant respectfully submits that there is no motivation to combine the cited references as suggested by the Examiner. For example, the Dolan '980 reference does not appreciate the problem of securely processing a challenge code, but instead discusses postage value transactions. As the Federal Circuit has held, "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art ..." See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998)).

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Accordingly, the references are not properly combined and the rejection should be reversed.

B. Claims 1 and 6-7 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1, 5 and 8-9 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by United States Patent No. 5,812,400 to Eddy, et al. ("Eddy '400") in view of U.S. Patent No. 4,812,965 to Taylor ("Taylor '965").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Claim 1 is directed to a method for verifying the location of a postage meter and is shown below:

1. A method for verifying that a postage metering system is located at a specific location, the method comprising the steps of:
generating a code at a data center, the code being associated with the postage metering system;
creating a challenge card having the code therein;

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sending the challenge card via a carrier service to the specific location;

retrieving the code from the challenge card and entering the code into the postage metering system subsequent to receipt of the code at the specific location;

communicating the code retrieved from the challenge card from the postage metering system to the data center; and

comparing the code received at the data center from the postage metering system to the code generated at the data center to verify that the postage metering system is physically located at the specific location. (emphasis added).

In the October 29, 2003 Final Office Action, the Examiner rejected claims 1, 5 and 8-9 under 35 U.S.C. section 103(a). Appellant respectfully disagrees with the rejection and urge its reversal for at least the reasons stated below.

The Examiner cites to Eddy '400 to teach a code and has provided an at least arguably strained definition of code that encompasses the order number taught in Eddy. As taught in the present application at page 5, line 30 through page 6, line 5, the code is more than a simple number and encodes information to associate it with a postage meter such as by a cryptographic process on a meter serial number. Furthermore, the Examiner cites to Eddy '400 but admits that it does not teach or suggest creating a challenge card or sending the card to a specific location. Eddy discusses an order number that would presumably be previously in the possession of the customer. There would be no motivation to send such a number by carrier to a customer and there would be no motivation to combine the teachings of Eddy '400 with Taylor '965 for use in a challenge system.

The Examiner has not put forth a prima facie case of obviousness. For example, the code is associated with the postage metering system. The challenge card has the code therein and the challenge card is sent to the specific location of the postage metering system using a carrier service. In the invention as presently claimed, a user could not use a duplicate indicium card received at another location because the code is associated with the postage metering system and it is on the challenge card that is sent

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to the specific location. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Dependent claim 5 and independent claims 8-9 include similar elements and are patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 1, 5 and 8-9 is in error and should be reversed.

C. Claims 2-4 are Not Unpatentable Under 35 U.S.C. section 103(a)

Claims 2-4 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 5,812,400 to Eddy, et al. ("Eddy '400") in view of GB 2,213,302 to Taylor ("Taylor '302") and further in view of U.S. Patent No. 5,731,980 to Dolan, et al. ("Dolan '980").

Claim 2 is directed to a method for verifying the location of a postage meter and is shown below:

2. A method as recited in claim 1, wherein the code generated at the data center is cryptographically secured.
(emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. As described above, the references are not properly combined. The claims are patentable for at least the reasons stated above with reference to independent claim 1.

The Examiner cites to Eddy '400, but discusses an account number for which there would be no reason to cryptographically secure. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Claims 3 and 4 that depend directly or indirectly from claim 2 include similar elements and are patentable over the cited references for at least the same reasons. For at least the above stated reasons, Appellant respectfully submits that the final rejection as to claims 2-4 is in error and should be reversed.

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D. Claims 6-7 are Not Unpatentable Under 35 U.S.C. section 103(a)

Claims 6-7 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. 103(a) as allegedly being rendered obvious by United States Patent No. 5,812,400 to Eddy, et al. ("Eddy '400") in view of GB 2,213,302 to Taylor ("Taylor '302") and further in view of U.S. Patent No. 5,731,980 to Dolan, et al. ("Dolan '980").

Claim 6 is directed to a method for verifying the location of a postage meter and is shown below:

6. A method as recited in claim 1, wherein the challenge card is one of a smart card, a floppy diskette, or a CD-ROM. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. As described above, the references are not properly combined. The claims are patentable for at least the reasons stated above with reference to independent claim 1.

The Examiner cites to Eddy '400 but does not describe why an account number would be transferred in such a way. Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

For at least these reasons, Appellant respectfully submits that the final rejection as to claims 6-7 is in error and should be reversed.

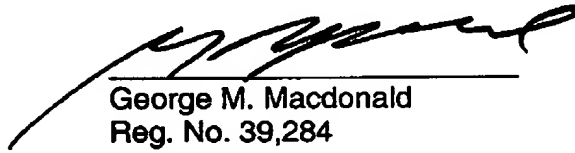
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IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-9 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

1. A method for verifying that a postage metering system is located at a specific location, the method comprising the steps of:
 - generating a code at a data center, the code being associated with the postage metering system;
 - creating a challenge card having the code therein;
 - sending the challenge card via a carrier service to the specific location;
 - retrieving the code from the challenge card and entering the code into the postage metering system subsequent to receipt of the code at the specific location;
 - communicating the code retrieved from the challenge card from the postage metering system to the data center; and
 - comparing the code received at the data center from the postage metering system to the code generated at the data center to verify that the postage metering system is physically located at the specific location.
2. A method as recited in claim 1, wherein the code generated at the data center is cryptographically secured.
3. A method as recited in claim 2, wherein the code is cryptographically secured using secret key cryptography.
4. A method as recited in claim 3, wherein upon the entering of the code retrieved from the challenge card into the postage metering system the postage metering system decrypts the code retrieved from the challenge card to verify its authenticity.
5. A method as recited in claim 1, wherein the challenge card is a printed card.
6. A method as recited in claim 1, wherein the challenge card is one of a smart card, a floppy diskette, or a CD-ROM.

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7. A method as recited in claim 6, wherein the code is electronically retrieved from the challenge card and electronically entered into the postage metering system.

8. A metering system comprising:

means for accounting for value dispensed by the metering system;

a challenge card having a code therein associated with an identification of the accounting means, the challenge card received from a carrier service;

means for entering the code obtained from the challenge card into the accounting means; and

means for communicating the entered code from the accounting means to a remote data for use in verifying the location of the accounting means.

9. A method for verifying that a value dispensing system is located at a specific location, the method comprising the steps of:

generating a code at a data center, the code being associated with the value dispensing system;

creating a challenge card having the code therein;

sending the challenge card via a carrier service to the specific location;

retrieving the code from the challenge card and entering the code into the value dispensing system subsequent to receipt of the code at the specific location;

communicating the code retrieved from the challenge card from the value dispensing system to the data center; and

comparing the code received at the data center from the value dispensing system to the code generated at the data center to verify that the value dispensing system is physically located at the specific location.

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Date: May 3, 2004

Subject: Serial No.: 09/220,830

Pages: 12 (including this cover)

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Re: U.S. Patent Application Serial No.: 09/220,830
Our Docket # E-826

Enclosed please find Appellant's Brief on Appeal in furtherance of the March 1, 2004 Notice of Appeal.

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1. Appellant's Brief on Appeal (11 pages).

on May 3, 2004
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